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10/654,301	09/03/2003	Steven J. Ross	GP-303673/GP-303674 (2760)	4415
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GENERAL MOTORS CORPORATION			NGUYEN, CUONG H	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/654,301	ROSS ET AL.	
	Examiner	Art Unit	
	CUONG H. NGUYEN	3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09 December 2008.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-5,8-15 and 18-26 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 1-5,8-15 and 18-26 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

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1. This is the answer to a communication filed on 12/09/2008.
2. Claims 1-5, 8-15, and 18-26 are pending.

Drawings

3. 6 sheets of formal drawings are accepted.

Response

4. The examiner withdraws previous action mailed on 9/09/2008 because a restriction requirement has not made by the applicants as required; this action is a non-final office action.

Restriction for examination purposes as indicated is proper because all these inventions (method, system, and computer-readable medium) listed in this action are independent or distinct and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

(a) the inventions have acquired a separate status in the art in view of their different classification;

(b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries/strategies);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Election/Restrictions

This application also contains claims directed to the following patentably distinct species of the claimed invention:

5. Since the specification clearly shows that a condition/requirement for this invention is “stationary period” or “no stationary period”; applicants are required to elect one of those two requirements (see para.[0040] in the disclosure: “In one embodiment, the download status is determined based on the ignition status of the mobile vehicle. In another example, the download status is a variable status requiring the mobile vehicle maintain a stationary period for a predetermined variable time period depending on the new preferences. In this example, certain new preferences, such as, for example modifying radio pre-sets include a requirement for a very limited stationary period or no stationary period for implementation of the preference” .

The examiner respectfully submits that pending claims that clearly mention of a “stationary period” (i.e., claims 1-2, 4, 25, 11, 21, and 26) are belong to a species of “no stationary period” (i.e., claims 3, 5, 8-10, 12-15, 18-20, and 22-24). A request to confirm whether applicants claim a “stationary period” embodiment, or a “no stationary period” embodiment because these two embodiments are clearly different.

6. Please see also MPEP 806.04(c) of a definition for Subcombination Not Generic to Combination. This situation is frequently presented where two different combinations are disclosed, having a sub combination common to each. This was recognized in Ex parte Smith, 1888 C.D. 131, 44 O.G.1183 (Comm'r Pat.1888), where it was held that a sub combination was not generic to the different combinations in which it was used.

A. Group I: representing by claim 1 (i.e., covering claims 1-2, 4, and 25), and claim 5:

Restriction on combination, and subcombination is required:

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- “method” claims 1-2, 4, 6, and 25 are of a form B_{specific}; i.e., having limitations:

- a. receiving a vehicle settings update signal at a call center from the telematics unit;
- b. determining a download status of the telematics unit and associated components, wherein the download status is a fixed status requiring the mobile vehicle to maintain a stationary period for a predetermined fixed time period;
- c. storing the vehicle settings when the download status of the telematics unit and associated components is negative; and
- d. transmitting the vehicle settings from the call center to the telematics unit when the download status of the telematics units and associated components is positive.”

- “method” claim 5 is of a form AB_{broad} - i.e., comprising limitations:

For “A”

- c. receiving a user preference at a call center via a web portal interface prior to the call center receiving the vehicle settings update signal; and
- d. sending an update flag signal from the call center to the telematics unit responsive to receiving the at least one user preference at the call center via the web portal interface and prior to the call center receiving the vehicle settings update signal”;

and B_{broad} comprises limitations:

- a. receiving a vehicle settings update signal at a call center from the telematics unit; and
- b. sending vehicle settings from the call center to the telematics unit responsive to the update signal.

The applicants need to elect (within this group I) between B_{specific} and AB_{broad}

B. Group II: representing by claim 1 (i.e., covering claims 1-2, 4, and 25), and claim 3.

And, the same thing as in A (Group I - above) happens to claims 1-2, 4, 25 and 3:

are of a form B_{specific}; i.e., Claim 1 is directed to a method comprising limitations of:

- a. receiving a vehicle settings update signal at a call center from a telematics unit;

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- b. determining a download status of the telematics unit and associated components, wherein the download status is a fixed status requiring the mobile vehicle to maintain a stationary period for a predetermined fixed time period;
- c. storing the vehicle settings when the download status of the telematics unit and associated components is negative; and
- d. transmitting the vehicle settings from the call center to the telematics unit when the download status of the telematics units and associated components is positive.
 - “method” claim 3’s limitations are of a form AB_{broad}
 - (i.e., this claim comprises limitations:

Where A:

- c. sending an update flag signal from the call center to the telematics unit prior to the call center receiving the vehicle settings update signal.

, and B_{broad}

- a. receiving a vehicle settings update signal at a call center from the telematics unit; and
- b. sending vehicle settings from the call center to the telematics unit responsive to the update signal.

The applicants again need to elect (within this group II) between B_{specific} and AB_{broad}

C. Group III: representing by a system claim 21, and system claims 22-24.

Claim 21’s limitations are of a form B_{specific}; i.e., Claim 21 is directed to a system comprising limitations of:

- a. means for receiving a vehicle settings update signal at the call center from the telematics unit;
- b. means for determining a download status of the telematics unit and associated components, wherein the download status is a fixed status requiring the mobile vehicle to maintain a stationary period for a predetermined fixed time period;
- c. means for storing the vehicle settings when the download status of the telematics unit and

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associated components is negative; and

d. means for transmitting the vehicle settings from the call center to the telematics unit when the download status of the telematics units and associated components is positive.

“system” claims 22-24’s limitations are of a form AB_{broad} (i.e., A system comprising limitations:

Where A:

b. means for transmitting a download requirement to the telematics unit;

c. means for receiving a download reply from the telematics unit responsive to a download requirement;

d. means for determining a download status of the telematics unit and associated components based on the received download reply;

, and B_{broad}

a. means for receiving a vehicle settings update signal at the call center from the telematics unit;

e. means for storing the vehicle settings when the download status of the telematics unit and associated components is negative; and

f. means for transmitting the vehicle settings from the call center to the telematics unit when the download status of the telematics units and associated components is positive.

The applicants again need to elect (within this group III) between B_{specific} and AB_{broad}

7. Applicants are required under 35 U.S.C. 121 to elect a single disclosed species (in group I, II, III), and a specific embodiment (in section 5 above) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable – currently, generic/BROADEST claim 3 is not allowable because it CLEARLY contains teaching ideas (because this is a method claim) about already well-known steps of:

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- receiving a signal at location B (sending from location A),
- in response, sending signals from location B to location A for settings (a feedback signal); and
- sending an extra signal (e.g., an update signal) from location B to location A.

Conclusion

8. Pending claims 1-5, 8-15, and 18-26 are not patentable.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759 (email address: cuong.nguyen@uspto.gov). The examiner can normally be reached on 7:30 am - 3:30 pm (Mon. – Tues., and Thurs. – Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

/CUONG H. NGUYEN/
Primary Examiner
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